



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,108	10/19/1999	HANS HSU	3783-4001	3647

23117 7590 04/26/2004
NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,108

Applicant(s)

HSU ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 195-214, 216-230 and 232-239 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 195-214, 216-230 and 232-239 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3624

DETAILED ACTION

1. This communication is in response to amendment filed 2/6/04.

Response to Amendment

2. claims 195, 196, 199, 200, 202-205, 207-209, 211,212, 218-220, 226-228, 234 and 237 have been amended per request.

3. claims 195-214,216-230 and 232-239 are pending.

4. rejection of claims under 35 USC 112 and Objection to claims cited in prior office action have been withdrawn.

Response to Arguments

5. Applicant's arguments filed 2/6/04 have been fully considered but they are moot in view of new grounds of rejection. See accompanying text of claim rejection.

Statute Cited in Prior Action

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

7. Claims 195, 196, 198, 201, 204-212, 216-220, 226-228 and 234 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and further in view of Smutko et al (Bridal Business can be the icing on your cake., Chilton's Hardware Age, v230, n11 p33(3), Nov, 1993) (Smutko).

Art Unit: 3624

Claim 195: Ucopia discloses a method for enabling a plurality of gift givers to each make a respective commitment for monetary contribution of any giver-desired amount toward a gift for a gift recipient, the method comprising:

Receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient ("couples can choose items from an extensive list ...to build a personalized registry"..., para 5);

Storing the gift ideas in a memory which is part of, or accessible to, said gift registry computer system (this step is inherent in Ucopia, since the items chosen by the registered couples are to be presented to the potential gift givers via the gift registry);

providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line of gift ideas (Ucopia: "guests enjoy the convenience of accessing all the selections in one place, and purchasing online...", para. 5);

receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward a purchase price of a gift selected from the on-line display of gift ideas (Ucopia: higher-priced items may be designated for group purchases, allowing guests to collectively contribute

Art Unit: 3624

towards gifts..., (refer to "Ucopia features" para 7). Since Utopia facilitates collective contributions from the gift givers towards gifts, receiving commitments from the gift givers for monetary contributions for the gift (designated for group purchase) is a required step);

Combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the an uncommitted balance of the selected gift's purchase price (since the gift(s) selected for collective purchasing are designated as such, informing a potential contributor is informed of the commitment (monetary amount) already committed or uncommitted balance of the gift's total purchase price);

Automatically generating a purchase request for the selected gift if the total of the commitment is equal to or greater than the selected gift's purchase price(Ucopia instantly updates couple registries after purchases..., the automatically generating purchase request step is anticipated because the registered gift is designated for purchase via the registry);

Attempting to satisfy the purchase request (see discussion of above limitation "automatically generating purchase request...));

Ucopia or Smutko fail to disclose that the commitment of each giver that commits to make a monetary contribution is for

Art Unit: 3624

any giver-desired portion of the uncommitted balance of the gift's purchase price. This is because, Utopia requires that the monetary contribution that a giver wish to commit be specified and communicated in terms of monetary equivalent shares (dollar amounts shares to be sold, Utopia).

It should be noted that broadly interpreted Utopia in no way restricts the monetary value of a share of a gift item, only the number of shares a giver may purchase (as noted by the applicant) is restricted to "one or more". This means a recipient may attribute a value of a penny (or a smallest denomination of currency) which would enable the givers to commit "any" desired monetary amount towards the gift since amount may be expressed in any giver desired amount albeit still expressed as shares of the gift item.

Smutko, in the same field of endeavor, discloses a concept of gift registry, which discloses a well-known concept of "group buy" (p.3). Smutko teaches that in a group buy a plurality of givers (Gift buyers) each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price (this is inherent since Smutko, like in any group giving situation discloses a required process of recording commitment of each giver). Smutko, also,

Art Unit: 3624

require that the price information communicated to and commitments received from each giver be expressed in terms of monetary amounts (dollars and cents).

Therefore, in view of Smutko, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Utopia gift registry method in accordance with Smutko, the method of group buying where the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price. Because, doing so would allow the givers to contribute any desired monetary amount towards an expensive gift, thereby not restricting the monetary contribution to a multiple of share price designated. This would allow more gift givers to participate to commit monetary amounts towards purchase of expensive gifts for which they like to participate as a member of the group. Another advantage of this modification of Utopia in accordance with Smutko would be that it would allow the recipient to specify the required amount of the gift in straight monetary units, i.e. Dollars and Cents (or nearest Dollars for convenience) knowing that more givers would participate towards the gift designated for group purchase, unlike in Utopia which requires to the recipient to arbitrary set a number of shares for a gift idea designated for group

Art Unit: 3624

giving which restricts the givers to only a multiple of share units.

Utopia or Smutko does not expressly show that the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the selected gift's purchase price.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps of receiving commitments or combining the commitments. These steps would be performed the same regardless of the data (i.e. regardless of the attributes of the giver's contribution). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, in view of the aforementioned non-functional recitation of the "wherein.. limitation" and in view of *In re Gulack* as analyzed above, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide for the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the selected gift's price because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 196: The cited references fail to teach that the commitment of each giver that commits to make a monetary contribution is directly specified by the giver as an amount of currency.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps of receiving commitments or combining the commitments. These steps would be performed the same regardless of the data (i.e. regardless of the attributes of the giver's contribution). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, in view of the aforementioned non-functional recitation of the claimed limitation and in view of *In re Gulack* as analyzed above, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide for the commitment of each giver that commits to make a monetary contribution as an amount of currency because the functionality of receiving of the commitments at the gift registry and combining the

Art Unit: 3624

commitments would be performed regardless of the manner in which each giver specifies a monetary contribution and because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claim 198: sending the purchase request to a supplier
(inherent feature of an on-line purchase such as Ucopia).

Claim 201: receiving credit card information supplied by
the gift givers that make commitments (extremely conventional
method of payment and therefore anticipated for gift purchase
and/or commitment of gift amount).

Claims 204-206, 216-217, 224-225, 232-233 and 238-239: The
cited references fail to teach, however, official notice taken
that features of receiving cash if the total of commitments is
less than the gift's purchase price, one or more gift-ideas
specified by the gift recipient is associated with a recipient
is associated with a recipient determined price (or vendor). It
would have been obvious to one of ordinary skill in the art at
the time of the invention for the gift registry to provide
different options of returning the received total gift amount in
the event that sufficient gift amount is not received, such as
cash (or equivalent gift certificate as Utopia discloses) as
business policy since the recipient would have choice to use the
cash as they desire.

Art Unit: 3624

Note that Claims 207 and 208 have been analyzed as per corresponding method claim 195. Since Utopia method is implemented over the Internet both Computer-readable medium that store instructions and a programmed computer that is programmed to perform the method step are inherent to Utopia.

All limitations of system claims 209 have been analyzed as in corresponding method claim 195.

Claim 210: communication network is the Internet (para 1,...the Internet's leading gift registry..).

Claim 211: limitation of the gift giver directly specifying the contribution as an amount of money is discussed in claim 195 as a combination of Utopia and Kmutko.

Claim 212 is analyzed similarly as per claim 195 with the following further explanation of the applied references:

Kmutko teaches that the gift price (total gift amount) is specified in dollar amount and the members of the group buy commits (pays) a part of the total gift amount of the gift (amount paid by a giver towards the purchase of the gift). Also note that the aforementioned commitment of each giver for part of the total gift amount is directly specified by the gift giver as an amount of currency (the amount reflects amount of currency paid by a buyer).

For motivation of combining the Utopia and Smutko please refer to analysis of claim 195.

Claims 216-217 are analyzed per claims 204 and 205 respectively.

Claims 218 and 219 have been analyzed as per corresponding method claim 212. Note that since Utopia method of gift giving is computerized (internet based) both storage medium (claim 218) and a computer system are inherent therein.

Claim 220: This claim requires that each gift idea received and stored has corresponding "specified total gift amount". The gift ideas and the gift amounts are then displayed to gift givers who commit a part of the total gift amount for a selected gift idea. Commitments from gift givers for the gift ideas are combined and purchase request is (automatically) generated if the total amount of the commitments for a gift idea is reached or exceeds the specified total gift amount for that gift idea.

The analysis of claim 195 already reflected "specified total gift amount" as "price" of the gift. All other steps were predicated on the gift giver knowing the price (any giver desired monetary amount) as discussed as in combination of Utopia and Smutko.

Claims 226 and 227 have been analyzed as per corresponding method claim 220. Note that since Utopia method of gift giving

Art Unit: 3624

is computerized (internet based), therefore, both storage medium (claim 218) and a computer system are inherent therein.

Claims 228 and 234 are analyzed as per corresponding method claims 212 and 220 respectively.

8. Claim 197, 213, 221, 229 and 235 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ucopia and Smutko as applied to claim 195 and further in view of weddingchannel.com.

(Exemplary analysis of claim 197 applies to other aforementioned claims)

Claim 197: generating one or more web pages based on gift ideas supplied by the gift recipient; and supplying the generated web pages to the gift givers in response to giver-supplied requests (refer to link "view item" next to the item listed, the giver is supplied with the web pages pertaining to the gift of interest);

Ucopia as applied to claim 195 fail to clearly recite the features of aforementioned claims. However, as discussed above, weddingchannel.com discloses generating web pages, supplying web pages to gift givers. It would have obvious to one of ordinary skill in the art at time of the claimed invention to implement these steps in Ucopia/Smutko combination as analyzed per claim 195.

Motivation for adding this feature is to provide the giver all necessary information and graphic display about the gift item so as to help him or her view the gift item and make decision towards gift purchase.

Art Unit: 3624

9. Claims 199 and 200 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Smutko as applied to claim 195 and further in view of Ojha et al (US Pat. 6,598,026) (Ojha)

Claim 199: Utopia as applied to claim 195 fail to teach features of sending an offer to purchase the selected gift to a plurality of vendors and subsequently receiving an acceptance of the offer from one of the vendors and requesting the accepting vendor to send the selected gift to the recipient. However, Ojha, in the same field of endeavor discloses a method for brokering transactions. Ojha teaches sending offers to purchase the selected (gift) item (a plurality of products, abstract) to a plurality of vendors (sellers), an acceptance of the offer from one of the vendors and accepting offer as per claim 199. It would have been obvious to one of ordinary skill in the art at the time of invention to implement in Utopia/Smutko combination as analyzed per claim 195, the feature of sending purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor as per Ojha because this would provide the most competitive price of the selected gift item for the buyer.

It is asserted that limitation "wherein.." is recited as a non-functional limitation as explained in claim 195 analysis.

Art Unit: 3624

For further explanation of treatment of non-functional descriptive material in the claim please refer to the analysis of claim 195.

All other limitations of claim 199 are analyzed as per claim 195.

Regarding claim 200, the cited references of Utopia and Smutko as discussed in analysis of claim 195 fail to teach adding the purchase request and aggregating purchase request while they teach sending the offer to a plurality of vendors to fulfill the offer of the gift item. Ojha, in the same field of endeavor, discloses sending request for a purchase of a plurality of products and subsequent consummation of the purchase request (bid) (see abstract and Background of the Invention).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the steps of adding purchase request and aggregating purchase request and sending purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor because this would provide the most competitive price of the selected gift item for the buyer. Aggregating purchase request for

Art Unit: 3624

identical products would allow the purchaser to receive more favorable price due to volume discount.

It is asserted that limitation "wherein.." is recited as a non-functional limitation as explained in claim 195 analysis. For further explanation of treatment of non-functional descriptive material in the claim please refer to the analysis of claim 195.

All other limitations of claim 200 are analyzed as per claims 195 and 199.

10. Claims 203, 215, 223, 231 and 237: are rejected under 35

U.S.C. 103(a) as being unpatentable over UCOPIA and Smutko as applied to claim 195 and further in view of Linstedt (Shoppers Sweep into Area Stores), Buffalo News, November 29, 1997. (Linstedt).

Claims 203 (exemplary): UCOPIA fail to disclose, however, in the same field of endeavor, Linstedt discloses, that when shopping for gifts the receivers desire a substitute gift item in lieu of a specific gift item. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the recipient specify a substitute option added to Ucopia/Smutko combination as analyzed per claim 195 because it

Art Unit: 3624

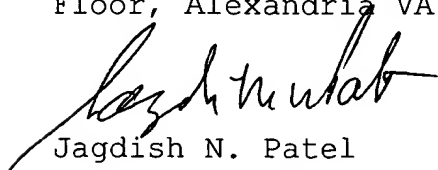
would ensure that a gift item similar to the one substituted for is available for the givers to select from.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Primary Examiner, AU 3624)

4/19/04